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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,114	05/30/2001	Barry John Smith	P68.2-9957	6534

490 7590 08/26/2003

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

VALENTINE, DONALD R

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 08/26/2003

5

PTO-90C (Rev. 07-01)

Office Action Summary

Application No.

09/870,114

Applicant(s)

SMITH ET AL.

Examiner

Donald R. Valentine

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-21, 27 and 31-33 is/are allowed.
- 6) ☒ Claim(s) 1-14, 22-26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-14, 26 and 28-30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “a lateral stripper”, does not reasonably provide enablement for “the lateral piercer”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification does not provide a description of the “lateral piercer” or how it functions in the apparatus combination claimed.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14, 26 and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 1 recites the limitation "lateral piercer" in line 17. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menendez et al in view of Canadian No. 2,178,776 and Kaneko et al.

Menendez et al show a cathode support frame stripping assembly being moveable relative to the cathode support frame and having a lateral piercer, which appears to be the functional equivalent of applicant's "stripper". The piercer is adapted to bias away from the cathode being stripped of a zinc sheet deposited thereon. A "scraper device" is shown at (Figs. 12-14).

Menendez et al do not show a movable base frame nor a power source applied to the base frame.

Canada No. 2,178,776 shows a device for stripping zinc deposits from cathodes in which the stripping assembly (56) is movable along a floor and has a stripper moveable across cathode deposits. The reference shows a moveable base, which includes wheels, which support the base on the floor and are hydraulically powered. See page 24, lines 3-7.

Kaneko et al provide a stripping assembly, which is laterally operable and has a moveable base for moving the device along the floor. The apparatus has advantages in that the apparatus may occupy relatively small floor space. (Col. L, lines 65-68).

It would be considered within the skill of the art to provide an alternate to a the fixed apparatus of Menendez et al and provide mobility to Menendez et al because both secondary references suggest the mobility feature to be advantageous should the skilled artisan find it necessary to conserve space.

Applicant's disclosure appears to consider this feature to be in common with the prior art.

See In re Lindberg 93 USPQ 23 and In re Wolfe 116 USPQ 443.

Claim 22-25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canadian No. 2,178,776.

The reference shows a device, which has a movable base frame (42), cathode support frame (21, 26, 28), stripping assembly (56) and a cathode washing device (80) which is considered to be a "cathode cleaner". See page 27, lines 20-28.

The reference does not mention a power source connected to the base frame and the stripping assembly.

However, it would be considered within the skill of the art to provide a power source because the reference is automatically operated and several elements of the device are indicated as being powered by electricity and/or hydraulic devices.

Allowable Subject Matter

5. Claims 15-21, 27 and 31-33 are allowed.
6. Claims 7-14, 26, 28-30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
7. The following is a statement of reasons for the indication of allowable subject matter: The references of record do not show or suggest a device for

stripping zinc sheets from cathodes in which there is a conveyor means and an associated bottom-up stacker assembly for receiving the separated sheets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R. Valentine whose telephone number is 703-308-3327. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Donald R. Valentine
Primary Examiner
Art Unit 1742

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August 12, 2003